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SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080			MA, JOHNNY	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/517,818
Filing Date: March 02, 2000
Appellant(s): OZ ET AL.

MAILED

AUG 28 2006

Technology Center 2600

Tarek N. Fahmi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 June 2006 appealing from the Office action mailed 13 March 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,907,321	Grossman et al.	5-1999
5,786,845	Tsuria	7-1998
6,029,045	Picco et al.	2-2000
5,892,508	Howe et al.	4-1999
6,182,126	Nathan et al.	1-2001

6,282,713 B1

Kitsukawa et al.

8-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2, 3, 5, 7, 8, and 23-39 are rejected under 35 U.S.C. § 103. This rejection is set forth in prior Office Action, mailed 13 June 2006.

(10) Response to Argument

As a preliminary matter, the Examiner notes that the Grossman et al. and Tsuria references are not redundant but are very similar, teaching the display of advertisements during a channel changing interval. The Tsuria reference was only relied upon for the teaching of periodically downloading from a server. As noted by Appellant, the previous Office Action conceded that the combination of Grossman et al. and Tsuria is insufficient to obviate the present invention. However, the rejection of the claims was not based on Grossman et al. and Tsuria references alone, as further discussed below.

Appellant argues that “[t]here is no suggestion or motivation to combine Picco, directed at permitting a broadcaster to deliver localized content to be inserted into the programming data, with Grossman and/or Tsuria, each directed at schemes for displaying information during channel changing intervals.” In support of this argument, Appellant points to the fact that “Picco allows individualized local content to be inserted into the programming data stream” wherein “[i]n contrast, Grossman/Tsuria disclose the display of visual images when a user changes the channels, during a delay between the displays of sequentially displayed channels.”

In response to applicant's argument that “[t]here is no suggestion or motivation to combine Picco, directed at permitting a broadcaster to deliver localized content to be inserted

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into the programming data, with Grossman and/or Tsuria, each directed at schemes for displaying information during channel changing intervals,” the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As discussed in the previous Office Action, the Grossman et al. reference the downloading of a number of visual images for access and display at a later time (Grossman 6:33-36) and “the visual image from the cable head end is displayed on television receiver 30 during ICI” (Grossman 3:53-55). Furthermore, the Grossman et al. reference discloses that the visual images displayed comprise advertising information (Grossman 3:31-40). Similarly, the Picco et al. reference also relates to the display of advertisements to television viewers with the further teaching of targeting the advertisements to provide individualized content to a household (Picco 6:23-34). . In response to applicant's argument that Picco is directed at a problem that is wholly unrelated to that discussed by Grossman and Tsuria and thus is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, as admitted by Applicant, both the Grossman and Picco references are directed towards applying transmitted advertising information to a television receiver display, providing advertisements to viewers. In response to applicant's argument that there is no suggestion to combine the references, the examiner

recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in view of the teachings of the Picco reference. The examiner respectfully submits that given the Grossman and Picco et al. references, the references would have suggested to one of ordinary skill in the art to modify Grossman's advertisements with Picco's targeted advertisements for the purpose of allowing advertisers to be able to more effectively reach viewers who are most likely to be interested in their products and often at a lower total cost since the advertiser does not have to purchase the rights to advertise in the entire market (Picco 2:62-67).

Appellant also argues that "[t]here is no suggestion or motivation to combine Howe, directed at interactive session relating to the content of television broadcasts, with Grossman/Tsuria directed at displaying visual images in response to a channel change" (Appeal Brief, pg. 4, Section C). The examiner respectfully disagrees. In response to applicant's argument that Howe is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the Grossman and Howe references are directed towards advertising and interaction with advertisements. Furthermore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that

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obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in the knowledge generally available to one of ordinary skill in the art. As noted in the previous Office Action, the Grossman et al. reference discloses advertisement interactivity wherein “the header information associated with an image can include...identification information. The identification information can include telephone, address, internet, web page address...Additionally, the identification information can be stored at cable headend 12, at a predetermined internet address or by a company providing the optical disk or magnetic tape containing the advertising information to the cable headend 12 for later access by the user” (Grossman 7:43-67). However, the Grossman et al. reference is silent as to the accessing of the identification information at a present time but clearly discloses “[t]he identification information can be stored for the most recently displayed images in order to permit later access by the user” (Grossman 7:54-56). The Howe et al. reference was relied upon to fill the gap, to teach interacting with an advertisement at a current time period. As noted in the previous Office Action, the Howe et al. reference teaches “the user has initiated an interactive session with a remote host by selecting an interactive element associated with the first one of the information elements” wherein “Content Provider B 42 may decide to transmit a broadcast, such as a commercial, having an associated interactive component or application...If the subscriber selects the displayed button, the STB 100 establishes a session with interactive server 5 and receives the interactive program or application

associated with the broadcast” (Howe 8:6-27). Both the Grossman et al. and Howe et al. references teach interactivity with commercials, the Grossman et al. reference teaching the interactivity with a commercial at a later time for accessing additional information while the Howe et al. reference teaches on-demand interactivity at a present time. Thus, the examiner submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Grossman et al. interactive advertisements with the Howe et al. on-demand interactive advertisements for the purpose of allowing the user to interact with the advertisement while it is being displayed to increase the likelihood of a purchase by a user.

Appellant further argues “[t]he rejection of claims 5, 32, and 33 is erroneous, because there is no suggestion or motivation to combine Nathan, directed at recording and reproduction of audiovisual information, with Grossman/Tsuria directed at displaying visual images in response to a channel change.” The examiner first notes that the Nathan reference was merely relied upon for teaching the well known method of buffering content prior for display to a user. In response to applicant's argument that the Nathan reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Grossman/Tsuria and Nathan references are all directed towards the display of content on a television display wherein buffering is a well known technique for content display. The Nathan reference was relied upon to teach the well known method of buffering content prior for display to a user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

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Grossman et al. storing of interchannel messages with the Nathan et al. queue using a memory and buffer for the purpose of displaying interchannel messages in order of receipt and a method for memory management so as to ensure the proper flow of data for display.

Regarding claim 28, Appellant argues “[c]laim 28 is Patentable over the combination of Grossman, Picco, Kitsukawa, and Tsuria” (Appeal Brief, pg. 5, Section E). Specifically Appellant argues that “one of ordinary skill in the art would not have been motivated to make the combination suggested by the examiner because the references themselves do not suggest such a combination and the problems being addressed therein are not at all similar.” Specifically, Appellant argues “Grossman is concerned with the display of information during times other than when a television picture is being displayed, i.e., during the delay period between the displays of sequentially displayed channels (Grossman et al. 3:46-55) and “Kitsukawa, on the other hand, is concerned with displaying information superimposed on a television picture... Stated differently, Kitsukawa is concerned with displaying information directly related to the content of the television picture, i.e., providing coupon information for products and services used in the scenes of television programs” (Appeal Brief, pg. 5, Section E). The examiner respectfully disagrees. In response to applicant's argument that Kitsukawa is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the Grossman and Kitsukawa references are related to advertising and providing additional information/functionality associated with advertisements. The Grossman reference discloses

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interactivity within an advertisement for obtaining additional information (Grossman 7:49-67).

Similarly, the Kitsukawa reference discloses obtaining additional information regarding products and services, such as those in advertisements (Kitsukawa 10:43-60). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in the knowledge generally available to one of ordinary skill in the art. As cited in the previous Office Action, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Grossman et al. and Howe et al. interchannel interactive advertising with the Kitsukawa et al. electronic transaction over the Internet for the purpose of providing the user the capability of purchasing an advertised product immediately and to increase sales of an advertised product or service over a the Internet, a well known and readily accessible network for facilitating communication of data.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

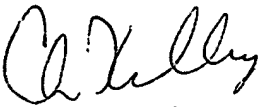
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